

REMARKS

Claims 1-4, 6-23, 25-42, 44-61, 63-89, 91-100 are now present in connection with the present application, with claims 98-100 being newly added. Claims 1, 20, 39, 57, 72, 86, and 98-100 are independent. Claims 5, 24, 43, 62 and 90 have been canceled without prejudice or disclaimer of the subject matter contained therein.

Telephone Interview

Initially, Applicants wish to thank Examiner Spooner for the telephone interview conducted on Thursday, October 27, 2005. In the interview, Applicants' representative discussed the differences between the various two and three letter combinations set forth in the O'Dell publication and the "word chunks" claimed in the claims of the present application. Applicants' representative indicated that the claims would be revised to clarify this distinction. Specifically, Applicants' representative proposed several potential clarifying amendments, including amending the claims to clarify that the word chunks were semantically meaningful. No agreement was reached, but the Examiner appeared to appreciate that the O'Dell publication, and its use of two letter or even three letter combinations which merely cumulatively added letters, did not utilize semantically meaningful word chunks (taken alone or in combination with the Mickunas patent). Thus, the present claims have been amended to clarify that

Discussion of Example Embodiment Illustrating "Semantically Meaningful Word Chunking"

Some advantages of such semantically meaningful word chunks over basic letter-type word predictions can be explained in the context of a highly agglutinating language, such as German for example. Regarding the word "zeitungsausschnitt" for example, if one were to try basic word predication or even two or three letter prediction, the word would be located very slowly after many key hits. First, for at least four hits (or two with two letter

combinations), the many words beginning with the chunk “zeit” would remain displayed. Thereafter, for the next three additional hits (or possibly fewer with some random letter combinations), the many more words beginning with the chunk “zeitung” would remain displayed. Thereafter, many more hits would likely be needed before “zeitungsausschnitt” was available for selection.

Instead, with the use of semantically meaningful word chunks, the word can be located efficiently by “chunking” through the word “zeitungsausschnitt” using semantically meaningful word chunks. First, the semantically meaningful chunk “zeit” is displayed, and in response to selection thereof, “zeitung” can then be identified and selected as another semantically meaningful word chunk. From there, the word “zeitungsausschnitt” can quickly be displayed for selection in an efficient manner.

Oath/Declaration

Applicants note that the objection to the Oath/Declaration is no longer present in this Office Action. Thus, Applicants presume that the objection has been withdrawn. Further, Applicants note that a new Supplemental Declaration was submitted on March 17, 2005, which is further believed to overcome the Examiner’s objection. Acknowledgement of entry of this Supplemental Declaration is respectfully requested.

Claim Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 1-4, 7-23, 26-42, 45-53, 55, 57 and 58 under 35 U.S.C. §103 as being unpatentable over O’Dell in view of Mickunas (U.S. Patent No. 5,040,113), the Mickunas ‘113 patent. This rejection is respectfully traversed and is further inapplicable to new claims 98-100 for at least the following reasons.

Claim Amendments

Initially, each of the claims has been amended to clarify that the word chunks are “semantically meaningful” word chunks, as agreed upon in the interview. Further, new claims 98-100 also include the aspect of “semantically meaningful” word chunks, which is not taught or suggested by the alleged combination of the O’Dell publication in view of the Mickunas ‘113 patent, even assuming arguendo that they could be combined.

Even if Combined, Alleged Reference Combination fails to meet all of the Limitations of the Independent Claims

As indicated above with regard to claim 1 for example, and indeed with regard to each of the independent claims in connection with the present application, the O’Dell reference fails to teach or suggest at least the limitation of **“semantically meaningful” word chunks**. Such examples of such chunks may include “zeit” and “zeitung” (used to predict the word “zeitungsausschnitt” for example), each of which has its own semantic meaning. Thus, in a language such as German for example, semantically meaningful word chunks can be chosen to chunk through word prediction of lengthy words such as “zeitungsausschnitt”, in a highly efficient manner.

To the contrary, neither the O’Dell publication nor the Mickunas ‘113 patent, even assuming arguendo that they could be combined, teaches or suggests the use of **“semantically meaningful” word chunks** as claimed. At best, the Mickunas ‘113 patent uses only letter by letter prediction and the O’Dell publication only teaches using some type of sequential multi-letter combinations which are not designated to be semantically meaningful.

Accordingly, withdrawal of the rejection and allowance of the claims, including new claims 98-100, is respectfully requested.

Further, Applicants note that the arguments set forth in the previous Amendment (the entire contents of which is incorporated herein) are

maintained (noting that neither reference does any “identifying” of a selectable word chunk, for example) and thus, for these additional reasons, withdrawal of the rejection is requested.

Lack of Motivation to Combine Reference Teachings

The Examiner merely sets forth his opinion that it would have been obvious to combine the teachings of the O'Dell patent with those of the Mickunas '113 patent, alleging that it would have been obvious to identify any prefix to the user which will have information concatenated upon in constructing a word. The alleged motivation is not true for the reasons set forth in the previous Amendment (the entire contents of which is incorporated herein); and is further merely “opinion” set forth by the Examiner. As such, it **is not proper motivation** for combining the references. Thus, the Examiner has failed to establish a proper prima facie case of obviousness under 35 U.S.C. 103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill art, or in some cases, the nature of the problem to be solved. In re Dembicczak, 50 USPQ2d 1614 (Fed.Cir. 1999). The statements made by the Examiner have nothing to do with why someone would be lead to combine the letter by letter prediction system of O'Dell with the program system of the Mickunas '113 patent. **The systems are completely distinct and have nothing to do with one another.** The Examiner has not provided any reasons of the desirability of making the specific combination that was made by the applicant.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide **particular findings** as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at

1617. **Broad conclusory statements standing alone, such as those set forth by the Examiner, without evidentiary support in the references, are not "evidence".** As such, they do not establish a prima facie case of obviousness under 35 U.S.C. §103(a).

In essence, the Examiner has used Applicants invention, in hindsight, as a blueprint. The Examiner's use of hindsight is clearly improper. The Examiner is not entitled to recognize deficiencies in prior art such as O'Dell, and then search only for the missing pieces of Applicants claim. **There is no reason to highlight entered letters in a word prediction system such as in O'Dell.** The Examiner must separately find evidence of reasons for making such a combination, independent of Applicants invention. The Examiner gives only "opinion", not evidence. Without this "evidence" of motivation, a prima facie case of obviousness under 35 U.S.C. §103(a) has not been established. Thus, the rejection is inapplicable and should not be maintained.

Further, relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner **must provide** an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) and MPEP 2144.03(c). Accordingly, Applicants respectfully challenge the Examiner's use of opinion or personal knowledge, and respectfully require the Examiner to withdraw the rejection or provide an Affidavit or Declaration as set forth above if the rejection is to be maintained. Accordingly, withdrawal of the rejection is requested.

Taking of Official Notice

Further, Applicants object to the Examiner's taking of official notice that it would have been obvious to one of ordinary skill in the art to include,

as one of the possible predetermined identifiers, a tilde. While Applicants do not necessarily dispute that the term identifier as claimed in claim 1 could include things other than a tilde, such as underlining or italics, Applicants respectfully again challenge the Examiner to find, in the prior art, the use of a tilde as an identifier in the context as claimed.

Additional Claim Rejections Under 35 U.S.C. §103

The Examiner has further rejected claims 6, 17, 19, 25, 36, 38, 44, 54 and 56 under 35 U.S.C. §103 as being unpatentable over O'Dell in view of Mickunas and further in view of Kadashevich et al. (the Kadashevich et al. '577 patent). This rejection is respectfully traversed.

Again, Applicants note that the independent claims have been amended and thus, for reasons previously set forth in the corresponding independent claims, Applicants respectfully request that the rejection be withdrawn. As previously stated, there are clearly deficiencies in the alleged combination of O'Dell in view of Mickunas regarding the newly amended independent claims, deficiencies which are not made up by the teachings or suggestions of the Kadashevich et al. patent, even assuming *arguendo* that they could be combined. Accordingly, withdrawal of the rejection is respectfully requested.

Further, regarding the alleged motivation for combining the references, Applicants respectfully suggest that proper motivation has not been provided and a *prima facie* case of obviousness has not been established. Thus, the combination of O'Dell in view of Mickunas and the Kadashevich et al. '577 patent is improper.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-4, 6-23, 25-42, 44-61, 63-89, 91-100 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
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By _____

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